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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 14
EWH/AKP

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sun Microsystems, Inc.

Serial No. 75/430,476

Sally M. Abel of Fenwick & West LLP for Sun Microsystems, Inc.

Jessie W. Billings, Trademark Examining Attorney, Law Office 103 (Michael Szoke, Managing Attorney)

Before Hanak, Walters and Rogers, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Sun Microsystems, Inc. (applicant) seeks to register PROCESSBEANS for "computer software for use in the development and deployment of application programs on a global computer network." The intent-to-use application was filed on February 9, 1998.

Citing Section 2(e)(1) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant's mark, as applied to applicants goods, is

merely descriptive. When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entemann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

At the outset, the Examining Attorney concedes that the term "processbeans" (whether spelled as one word or two words) does not appear in any dictionary, and for that matter, does not appear in any stories in the NEXIS database or in any other database. In order to establish that applicant's mark PROCESSBEANS is merely descriptive, the Examining Attorney has relied upon a dictionary

definition of the word "process," and stories taken from the NEXIS database wherein in the term "beans" appears.

We note that the dictionary relied upon by the Examining Attorney (TechEncyclopedia 1999) defines the word "process" as follows: "To manipulate data in the computer. The computer is said to be processing no matter what action is taken upon the data." The Examining Attorney's own dictionary definition of the word "process" demonstrates that this word as applied to computers and computer programs is extremely vague in that it indicates that all computers and computer programs are continuously engaging in the act of "processing."

As for the word "beans," the Examining Attorney contends that the NEXIS evidence demonstrates that "they are software development programs." (Examining Attorney's brief page 2). This point has been conceded by applicant at page 3 of its Request for Reconsideration.

Nevertheless, given the extremely vague nature of the word "process" as applied to computers and computer programs, we find that the composite term PROCESSBEANS is not merely descriptive because it fails to convey any information about the qualities and characteristics of applicant's computer software with the aforementioned required "degree of particularity."

Moreover, there exists a second reason for finding that the term PROCESSBEANS is not merely descriptive. We find that this term has a double meaning in that besides being a computer term, it also readily brings to mind the notion of "processed beans," a food item. Marks that have such double meanings are not considered to be merely descriptive. In re Colonial Stores, 394 F.2d 549, 157 USPQ 382, 385 (CCPA 1968).

Decision: The refusal to register is